



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,746	11/18/2003	Chad A. Stevens	200208268-1	7463
22879      7590      04/10/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
EXAMINER SAFAIPOUR, HOUSHANG				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
04/10/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM

mkraft@hp.com

ipa.mail@hp.com

# Office Action Summary

**Application No.**

10/716,746

**Applicant(s)**

STEVENS ET AL.

**Examiner**

Houshang Safaipoor

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-16 and 20-24 is/are rejected.
- 7) ☒ Claim(s) 9, 10 and 17-19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-8, 11-16 and 20-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Baird et al. (US 2005/0275871, and further in view of Kishimoto (US 2002/0035576).

Regarding claim 1, Baird discloses a method comprising:

providing digital image data (facsimile data);

determining an identity of a user associated with a communications device (page 1, paragraph [0010]); and

Although Baird teaches converting the contents of the fax to a TIFF file and then attaching it to an email message (page 4, [0073]), he does not explicitly disclose defining a modified version of the provided digital image data, based on the determined identity of the user. Kishimoto discloses "... file format conversion program module 183d" (page 4, [0055]) which converts the attached file to a format desired by the user (end of paragraph [0065]). Therefore it would have been obvious to a person of ordinary skill in the art to use such program in Baird's system in order to enable the users to view the attachments in a variety of formats (Kishimoto: abstract).

Regarding claim 2, Baird discloses the method of claim 1, wherein providing the image data, comprises: scanning a hardcopy document to produce the digital image data (facsimile).

Regarding claim 3, Baird discloses the method of claim 1, wherein providing the digital image data, comprises: receiving an image file for attachment to an email message ([0073]).

Regarding claim 4, Baird discloses the method of claim 1, wherein determining the identity of the user associated with the communications devices comprises accessing network login data associated with a device coupled to a communication network ([0067]).

Regarding claim 5, Baird discloses the method of claim 1, further comprising: accessing machine-identifying data in a memory associated with the communications device; wherein defining the modified version of the provided digital image data, based on the determined identity of the user includes defining the modified version based on the accessed machine-identifying data [0071-0074]).

Regarding claim 6, Baird discloses the method of claim 1, wherein determining the identity of the user comprises receiving data via a control panel of the communications device [0011].

Regarding claim 7, combination of Baird and Kishimoto discloses the method of claim 1, wherein defining the modified version of the provided digital image data, based on the determined identity of the user, comprises: retrieving image-modification data from a database, based on the determined identity; and defining the modified version of the provided image data based on the retrieved image-modification data (please refer to the arguments under claim 1).

Regarding claim 8, combination of Baird and Kishimoto discloses the method of claim 7, wherein defining the modified version of the provided image data based on the retrieved image-

modification data, comprises changing the image data to indicate identity of the user (Kishimoto teaches converting (changing) the attachment (image data) based on the user's identified format [Kishimoto, 0065]).

Regarding claim 11, combination of Baird and Kishimoto discloses the method of claim 1, further comprising communicating the modified version of the provided image data to a digital data receiver (Kishimoto, [0065]).

Regarding claims 12-14 the recitation "a machine readable medium" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding claim 12-15, please refer to the arguments under claim 1.

Regarding claim 16, combination of Baird and Kishimoto discloses the method of claim 15, wherein changing scanned image data associated with the hardcopy document, based on identity data associated with the digital image sender, comprises: determining identity of a user of the digital image sender, based on network login information for the user; retrieving image-modification data from a database, based on the determined identity; and changing the scanned image data based on the retrieved image-modification data (Kishimoto: [0056] and [0065]).

Regarding claim 20, combination of Baird and Kishimoto discloses an apparatus comprising: a scanner; a control panel; and a scanner; a control module coupled to the scanner and the control panel, the control module including: a processor; and a storage medium coupled to the processor including instructions for: determining an identity of a user associated with the apparatus; and defining a modified version of scanned image data from the scanner, based on the determined identity of the user (Kishimoto: [0053], [0056] and [0065]).

Regarding claim 21, combination of Baird and Kishimoto discloses the apparatus of claim 20, wherein the instructions for defining the modified version of the scanned image data, based on the determined identity of the user, comprise instructions for: retrieving image-modification data from a database, based on the determined identity; and defining the modified version of the image data based on the retrieved image-modification data (Kishimoto: [0056] and [0065]).

Regarding claims 22 and 23, combination of Baird and Kishimoto discloses the apparatus of claim 21, further including a network communications device for communicating the modified version of the scanned image data using a network communications protocol (Kishimoto: [0056]).

Regarding claim 24, combination of Baird and Kishimoto discloses the apparatus comprising: a scanner; a control panel; a scanner; and a control module coupled to the scanner and the control panel, the control module including: means for determining an identity of a user associated with the apparatus; and means for defining a modified version of scanned image data from the scanner, based on the determined identity of the user (Please refer to the arguments under claim 1 and also kishimoto [0053-0056]).

***Allowable Subject Matter***

3. Claims 9, 10 and 17-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Fri. from 6:00am to 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Houshang Safaipoor/  
Primary Examiner, Art Unit 2625  
March 31, 2008